

II. Rejection of under 35 U.S.C. § 103(a)

The Examiner maintains the rejection of claims 1-22 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,540,791 to Dias ("Dias"), in view of U.S. Patent No. 6,260,556 to Legrand et al. ("Legrand"), and further in view of U.S. Patent No. 6,423,306 to Caes et al. ("Caes") for reasons of record. Final Office Action, pages 2-5. The Examiner alleges that Dias teaches a hair bleaching composition comprising polydecene, nonionic amphiphilic polymers, peroxygenated salt, an alkaline agent, and surfactants as recited in the rejected claims. Final Office Action, page 2. The Examiner relies on Legrand and Caes for the disclosure of specific peroxygenated salts, hydrogen peroxide, and gelling agents not disclosed in Dias. See *id.*, pages 3-4. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make an anhydrous paste comprising a peroxygenated salt, an alkaline agent, a polydecene, and a gelling agent, as taught by Dias, in view of Legrand, and further in view of Caes. *Id.* at 5.

In addition, in response to Applicant's argument that, *inter alia*, Dias teaches water as a diluent and thus teaches away from an anhydrous product, the Examiner alleges that because Dias teaches "water as merely a *preferred* diluent" and mentions "alternatives to water," the "[d]isclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments." *Id.* at 6 (citing *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971) and MPEP § 2123) (emphasis original).

Applicant respectfully disagrees and traverses this rejection for the reasons of record and the following additional reasons.

First, the Examiner's reliance on *Susi* is improper. In *Susi*, the applicant argued that the subclass of a "more particularly preferred embodiment" taught away from the subclass of a "particularly preferred embodiment"; but the court determined that "one is not significantly 'taught away' from a 'particularly preferred embodiment' by the suggestion . . . that something else may be even better." *Susi*, 440 F.2d at 446, n. 3; 169 USPQ at 426, n. 3. Here, Dias discloses a single solution hair bleaching product, (col. 2, lines 9-10 and 24-25) but does not differentiate between bleaching solutions and anhydrous pastes, nor prefer one over the other. Indeed, Dias does not even teach or suggest a composition in the form of an anhydrous paste as recited in, for example, present claim 1.

In addition, Dias' composition comprises, "as an essential feature," a buffering system comprising water soluble compounds. *Id.* at col. 7, lines 2-10, 17-18, 60-61 (emphasis added). Dias discloses that its composition may comprise a diluent, which is preferably water. *Id.* at col. 44, lines 65-67. All of the examples disclosed in Dias use water as a diluent. *Id.* at col. 50, line 35. These disclosures, contained throughout the specification of Dias, all point away from an anhydrous product.

Contrary to what the Examiner has alleged, therefore, Dias has been considered as a whole, and as such, the reference teaches away from an anhydrous product. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) (emphasis added). Here, with its disclosure of a "single solution hair bleaching product" and its

teaching that its composition comprises, "as an essential feature," a buffering system comprising water soluble compounds Dias would have led one of ordinary skill away from an anhydrous paste as recited in, e.g., present claim 1.

Additionally, as the Examiner admits, the percentages of ingredients in Dias's composition differ from those in the presently claimed composition. Final Office Action, page 4. To address this deficiency, the Examiner cites *In re Woodruff*, alleging that "the applicant must show that the particular range is critical." *Id.* at 6. Applicant respectfully disagrees.

The Examiner's reliance on the *Woodruff* case is also improper. In *Woodruff*, the court determined that the claimed range overlaps the range disclosed in the prior art reference and held that the applicant must show that the particular range is critical. *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Here, however, there is no need to make such a showing. Dias discloses that its composition may comprise, among a laundry list of organic conditioning oils, polydecene in an amount ranging from about 0.05% to about 3% by weight of the composition. Dias, col. 22, line 42 - col. 25, line 15. This range is indeed outside, and much lower than, the amount of the at least one polydecene ranging from 15% to 35% by weight of the total weight of the paste as recited in, for example, present claim 1. There is no overlap. In addition, this difference in amounts of polydecene reflects a further fundamental difference between Dias's invention, which is directed to a bleaching solution, and the present invention, which is directed to an anhydrous paste. Therefore, contrary to the Examiner's allegations, it would not have been obvious for one of ordinary skill in the art to attain the parameters of the instant claims by routine experimentation.

The Examiner also alleges that "Dias shows that use of a polydecene compound having at least 30 carbon atoms in an anhydrous paste for bleaching human keratin fibers was within the level of ordinary skill at the time the claimed invention was made." Final Office Action, page 7. Applicant respectfully disagrees.

In an obviousness determination, the Examiner must show that there is some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference relied upon. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). The Supreme Court, in its recent decision in *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), recognized that a showing of "teaching, suggestion, or motivation" could provide helpful insight in determining whether claimed subject matter is obvious under Section 103(a). *KSR*, slip op. at 14.

In addition, the Supreme Court mandated that "[t]o facilitate review, this analysis [of whether there was an apparent reason to modify or combine the prior art reference in the fashion claimed by the patent at issue] should be made explicit." *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). Following the *KSR* decision, the Office issued a memorandum to its technology center directors on May 3, 2007, indicating that **"in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art**

would have combined the prior art elements in the manner claimed.” (Emphasis in original).

Here, the Examiner has failed to provide any explicit reason to choose polydecene from the laundry list of the organic conditioning oils disclosed in Dias in column 22, line 42 - column 25, line 15, let alone the specific polydecene of formula $C_{10n}H_{[(20n)+2]}$, wherein n ranges from 3 to 9, as recited in, for example, present claim 1. Further, contrary to the Examiner’s allegation, Dias does not disclose the use of a polydecene compound having at least 30 carbon atoms in an anhydrous paste for bleaching human keratin fibers. Instead, as discussed above, Dias’s composition is in a solution containing a water-soluble component. Therefore, this rejection is improper.

As for the secondary references, the Examiner merely relies on Legrand and Caes for the disclosure of specific peroxygenated salts, hydrogen peroxide, and gelling agents. See Final Office Action, pages 3-4. Neither Legrand nor Caes remedies the deficiencies of Dias as set forth above.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicant respectfully requests this rejection be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the pending claims are not obvious in view of the references cited against the rejected claims. Applicant therefore requests reconsideration of the application and timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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